

Application No. 10/761,670

REMARKS/ARGUMENTS

In the first Office Action, original claims 1-5, 8-10, 12 and 14 were rejected under 35 USC § 102(b) as being anticipated by Franko '085. Original claims 2-6, 8-10 and 12-14 were rejected under 35 USC § 102(b) as being anticipate by Stange '401. Original claims 7 and 11 were rejected under 35 USC § 103(a) as being unpatentable over Stange in view of Franko. However, the present amendment cancels all said original claims in favor of the present extensively amended claim 1.

Stange is a photoreceptor sheet stripping system and Franko is an elastomeric fuser roll stripping system, which is the subject of this application. It is respectfully suggested that amended claim 1 is not anticipated by either reference, and that there is also no requisite suggestion to combine these two different references, and that amended claim 1 is not fully taught even if these two references could be properly combined.

It is respectfully noted that according to MPEP § 2141, when applying 35 USC § 103, the examiner must adhere to the following basic tenets of patent law:

- A. The claimed invention must be considered as a whole;
- B. The references must be considered as a whole and must suggest the desirability of making the combination;
- C. The references must be viewed without the benefit of impermissible hindsight afforded by the claimed invention; and
- D. Obviousness must be determined under a reasonable expectation of success standard.

In order to establish a *prima facie* case of obviousness, patent examiners are required to establish three criteria:

- (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
- (2) There must be a reasonable expectation of success; and

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- (3) The prior art reference, or combination or references, must teach or suggest all the claim limitations.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.

The specification was formally objected to for failure to provide "headings" (subtitles) for the various sections. [There is no dispute that all the parts of this application are in the proper *order and sequence*.] This objection solely for not having such internal "headings" is respectfully traversed as *not* a USPTO *mandatory* requirement for patent applications, as the USPTO has acknowledged. These "headings" are merely *suggested* in 37 CFR 1.77 "Arrangement of application." 37 CFR 1.77 is *not* a *mandatory* PTO Rule. 37 CFR 1.77(c) says that the respective text, if applicable "SHOULD" be preceded by a section heading in uppercase [and not underlined or bolded]. There is no dispute as to the meaning of "should" in a PTO Rule. E.g., the August 1998 issue of the POPANEWS, the Patent Office Professional Association newsletter [reporting a PTO examiner arbitration decision] states that: "Noteworthy for examiners was [PTO] management's admission during the arbitration that the wording of a rule in the Manual of Patent Examining Procedure determines whether it is permissive or mandatory. PTO counsel and a management witness both agreed that the MPEP's use of 'should' means the rule is permissive, while the use of 'shall' states the rule is mandatory." Furthermore, another reason this rule is not mandatory is that the use of such subtitles within the specification is not allowed in many foreign equivalent patent applications, thus requiring amendments of U.S. specifications to remove them for foreign filing, contrary to PTO "harmonization" policies.

No additional fee is believed to be required for this amendment. However, the undersigned Xerox Corporation attorney hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

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A telephone interview is respectfully requested at the number listed below prior to any further Office Action, i.e., if the Examiner has any remaining questions or issues to address after this paper. The undersigned will be happy to discuss any further Examiner-proposed amendments as may be appropriate.

Respectfully submitted,



Paul F. Morgan
Attorney for Applicants
Registration No. 22,662
Telephone (585) 423-3015

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